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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,800	03/27/2001	Ronald P. Sansone	E-985	9888

919 7590 02/28/2005

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EXAMINER

BASS, JON M


ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JE

 Office Action Summary	Application No.		Applicant(s)		
	09/818,800		SANSONE, RONALD P.		
	Examiner		Art Unit		
	Jon Bass		3629		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is written in response to the communication called "Messaging Services for Mail", filed on March 27, 2001. Claims 1-31 are pending in this application.

Information Disclosure Statement

2. The Information Disclosure Statement (IDS), submitted on March 27, 2001 and January 27, 2003, are being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For an invention to be labeled as having statutory subject matter it must be within the statutory class that is described thoroughly in §101 (ex. machine, process, manufacture or composition of matter).

Currently, claims 1-31 are geared towards "A method that enables a recipient to inform a carrier about the mail delivery", which is not within one of the classes of the invention that is set forth in the §101 law.

The "A method wherein the recipient notifies the carrier" comprising the steps of (a) opening the mail, (b) return the mail to the sender, (c) delivering mail, (d) notification

options, display merely an conceptual idea and do not produce a useful, definite, and concrete results.

The “A method that enables a recipient to inform a carrier about the mail delivery” and “A method wherein the recipient notifies the carrier”, which encompasses the steps of (a)-(d) as dictated are merely an conceptual idea and doesn’t involve any technological art (computer or software) therefore identified as being non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-31 are rejected under 35 U.S.C., second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

Claim 1 is not clearly defined considering the interpretation of the preamble which states, “A method that enables a recipient to inform a carrier about the mail delivery”, but there are no procedures or limitations mentioned that state the measure in which the “recipients informs the carrier” in the body of the claim.

Claim Rejections - 35 USC § 112

5. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, pertaining to the disclosure which is not enabling. Some type of computer system or computer software is vital for this invention, but its not included in the claims, therefore not making it enable by the disclosure. A computer system is essential for this invention to be of novelty or usefulness.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 and 20-31 are rejected under 35 U.S.C. 102(b) as being anticipated by

Dimitri Kanevsky et al. (US Patent No 6,285,777), here on referenced as Kanevsky.

As per claims 1-14 and 20-31, Kanevsky et al. discloses a method that enables a recipient to inform a carrier how they would like their mail delivered, comprising the steps of:

- Kanevsky et al. discloses method in Figure 1, where the diagram illustrates a mail/internet connection.

- Kanevsky et al. discloses method in Figure 3, where the diagram illustrates a system for communication from an internet user to a mail receiver.
- Kanevsky et al. discloses method in Figure 5, where the diagram illustrates an example of information on an envelope relating to how and where a letter should be sent.
- A sender of a paper mail item (fig1, element 10)
- Sender sends message including the mail address for delivery of message (col.1, lines 33-36)
- Figure 1, items 14,16,18,30,20 of Kanevsky illustrates the process in which the message is being separated into two parts, one being the surface paper mail and the other as being routines by way of the internet mail which is then transferred into email information. (Col.2, lines 21-37).
- Prints a hard copy on paper to the addressee and delivers by local mail (Col.1, lines 40-42).
- The email data is transmitted to an internet user as internet mail (Col.2, lines 39-40, fig.2, element 20).
- Providing billing procedure (fig.2, element 39)
- The database can be connected to email and telephones. (Col.3, lines 22-25)
- Kanevsky discloses a method the describes the two separate mail choices, one being the mail route and the other being the internet routine with the internet route being faster then the mail route. (Col.4, lines 1-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dimitri Kanevsky in further view of Andrew Egendorf (US Patent No 5,794,221) here-on referenced as Egendorf.

As for Claim 15:

Kanevsky discloses a method, but lacks wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower delivery method than that paid for by the sender.

Egendorf discloses a method wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower delivery method than that paid for by the sender (fig 1, displays the billing method), internet is used to collect payment.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Kanevsky method in conjunction with Egendorf system to emulate a invention that deals with delivery of mail through the internet with billing procedures by way of the internet, which additionally verifies the products data and its origin.

As for Claim 16:

Kanevsky discloses a method, but lacks wherein the recipient notifies the carrier to deliver the mail to the recipient by a faster delivery method than that paid for by the sender.

Egendorf discloses a method wherein the recipient notifies the carrier to deliver the mail to the recipient by a faster delivery method than that paid for by the sender, (fig 1, displays the billing method), internet is used to collect payment.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Kanevsky method in conjunction with Egendorf system to emulate a invention that deals with delivery of mail through the internet with billing procedures by way of the internet, which additionally verifies the products data and its origin.

As for Claim 17:

Kanevsky discloses a method, but lacks further including the step of: charging the recipient for receiving notification of the availability of the deposited mail.

Egendorf discloses a method further including the step of: charging the recipient for receiving notification of the availability of the deposited mail, (fig 1, displays the billing method), internet is used to collect payment.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Kanevsky method in conjunction with Egendorf system to emulate a invention that deals with delivery of mail through the internet with billing procedures by way of the internet, which additionally verifies the products data and its origin.

As for Claim 18:

Kanevsky discloses a method, but lacks further including the step of: charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.

Egendorf discloses a method further including the step of: charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier, (fig 1, displays the billing method), internet is used to collect payment.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Kanevsky method in conjunction with Egendorf system to emulate a invention that deals with delivery of mail through the internet with billing procedures by way of the internet, which additionally verifies the products data and its origin.

As for Claim 19:

Kanevsky discloses a method, but lacks further including the step of: charging the recipient for receiving notification of the availability of the deposited mail; and charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.

Egendorf discloses a method including the step of: charging the recipient for receiving notification of the availability of the deposited mail; and charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the, (fig 1, displays the billing method), internet is used to collect payment.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify Kanevsky method in conjunction with Egendorf system to emulate a invention that deals with delivery of mail through the internet with billing procedures by way of the internet, which additionally verifies the products data and its origin.

Conclusion

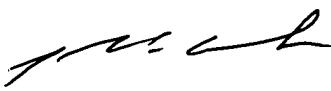
The prior art that was cited hasn't been used in conducting a decision but has been considered pertinent to the applicant's disclosure.

Any concerns in regard to this communication, the examiner **Jon Bass** can be reached at (703) 305-0383 between the hours of 9-6pm Monday through Friday until April of 2005. The fax number where the application is being process is (703) 308-3691.

If for any reason the examiner is unavailable, the immediate supervisor, **Thomas Dixon** can be reached at (703) 305-4645.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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